

INDUSTRIAL DESIGNS

What this section covers:

- Legislation
- Coverage – What Does the Law Protect?
- Registration
- Enforcement Approaches
- Other Measures
- FAQ

Legislation

Ghana

The Industrial Designs Act, 2003 (Act 660) (IDA) was adopted on December 31, 2003. Protection of textiles and textile designs, a chief concern for the Ghanaian population, were protected early on in Ghana, but the IDA expanded the protections significantly, particularly with respect to the increase of the protection period from 10 to 15 years. Applicants should be aware that the regulations implementing the IDA have only recently been drafted and as of April 2011 had not yet been submitted to Parliament. Applicants may wish to inquire of legal counsel as to the current status of the regulations.

Registration of an industrial design (ID) confers exclusive use of that ID on the rights-holder. The registration of an ID is valid for a period of five (5) years from the filing date of the application and may be renewed for two further consecutive periods of five years upon payment of a renewal fee.

Violations under the IDA are punishable by a fine not exceeding 2000 penalty units (currently a penalty unit is equal to GHC 12.00; the current maximum fine is GHC 24,000) or up to two years imprisonment or to both.

International

Ghana is a member of or has ratified the following international agreements regarding IDs:

- [The Convention Establishing the World Intellectual Property Organization \(WIPO\);](#)
- [The Paris Convention for the Protection of Industrial Property \(Paris Convention\);](#)
- [World Trade Organization \(WTO\) Agreement on the Trade-Related Aspects of Intellectual Property Rights \(TRIPS\);](#)
- [The African Regional Intellectual Property Organization \(ARIPO\);](#) and
- [The Protocol on Patents and Industrial Designs adopted in 1982 in Harare, Zimbabwe \(Harare Protocol\).](#)

The Paris Convention permits a priority filing with respect to its members. An international application may designate Ghana for an industrial design under the Harare Protocol.

Coverage – What Does the Law Protect?

The IDA defines an ID as a composition of lines or colors, a three dimensional form or a material, whether or not associated with lines or colors, or a textile design, where the composition, form or material gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft. Protection under the IDA does not extend to anything in an ID that serves solely to obtain a technical result to the extent that it leaves no freedom as regards arbitrary features of appearance.

Rights Conferred by Registration of an ID

Any exploitation of a registered ID by persons other than the registered owner requires the permission of the registered owner. Under the IDA, “exploitation” is defined as:

- making;
- selling;
- importing; or
- otherwise distributing for commercial purposes

articles bearing or embodying a design, which is a copy or substantially a copy of a registered ID.

Rights conferred by registration do not apply to acts in respect of articles which have been put on the market in any country by the registered owner or with the registered owner’s consent (“gray market goods”).

Registration

Applications for registration are filed with the Registrar-General’s Department (RGD). The registry is public, and extracts may be obtained by any interested person for a fee.

The creator has the right to registration of the ID, subject to work-for-hire provisions. Joint ownership is permitted. Two or more IDs may be the subject of the same application if they relate to the same class of the International Classification as set out by the Locarno Agreement of October 8, 1968, establishing an International Classification for Industrial Designs or to the same set or composition of articles. The applicant may withdraw the application at any time. A registered owner may surrender the ID by written declaration to the RGD, who will publish notice of the surrender. A decision taken by the RGD may be appealed to the High Court.

An ID is registrable if it is new, meaning that it significantly differs from known designs or combinations of known design features. An ID that is disclosed to the public is still eligible for protection if an application for registration is filed within 12 months of disclosure, or

where applicable, the priority date of the application, and was due to a result of acts committed by the applicant or applicant's predecessor in title or an abuse committed by a third party without regard for the rights of the registered owner. An ID contrary to public order or public morality is not registrable.

Set out below are the general steps for applying for registration of an ID in Ghana. Applicants should be aware that the regulations implementing the IDA have only recently been drafted and as of April 2011 had not yet been submitted to Parliament. Applicants are advised to inquire of legal counsel as to the current status of the regulations. Unlike trademarks or copyright, IDs have no previous regulations which attorneys or officials may look to in an effort to apply the law. Discussions with the RGD confirmed the steps for registration below; at the present time, however, all applications for IDs, with the exceptions of textile designs, are sent to ARIPO for processing. Whenever an applicant intends to apply for protection in Ghana, he or she will have to file it as a regional application designating Ghana. Once the regulations for the IDA are in effect, officials have advised us that it is likely that applicants will have the option of filing a national application for protection in Ghana only, or filing a regional application under ARIPO, or both. Once the national system is in effect, however, ID applications will continue to be sent to ARIPO under Ghana's ARIPO relationship and obligations.

The timeline regarding objections as outlined under the IDA below is based on the timeline for registration of trademarks, RGD officials having advised us that it is the same, but should be confirmed by applicants upon application. Applicants may wish to inquire of legal counsel as to the current status of the regulations. We recommend that you check the RGD website regularly for updates and current information. <http://rgd.gov.gh/>

Step One: Obtain Qualified Counsel

If the ordinary principal residence or principle place of business of an applicant is outside of Ghana, the applicant must be represented by a legal practitioner resident and practicing in Ghana. Applicants are encouraged to seek out firms that have experience in Ghanaian IP law.

Step Two: Establish a Priority Claim

A rights-holder who is a citizen of a state party to the Paris Convention or who is a member of the WTO may claim a priority of one or more earlier national or regional applications or international deposits. In such case, the RGD may require the applicant to furnish a copy of the earlier application or international deposit, certified as correct by the office with which it was filed.

Step Three: Prepare and Submit the Application

The application to the RGD must contain:

- A request, drawings, photographs or any other adequate graphic representations of the ID;

- An indication of the article which constitutes the ID or in relation to which the ID is to be used;
- Where the applicant is not the creator, a statement justifying the applicant's right to registration; and
- A declaration of priority, if applicable.

Where the ID is two-dimensional, the application may also contain a specimen of the articles embodying the ID. The application shall also include the payment of the current application fee.

Step Four: Examination

The RGD records the date of receipt of the application as the filing date if the application is complete. If it is incomplete, the RGD invites the applicant to file the required correction. If the RGD receives the information necessary, then the application is deemed complete as of the date of receipt of the required correction. If no correction is made, the applicant is treated as if it had not been filed. After the application is deemed complete, the RGD determines whether or not the application complies with the provisions of the IDA, including whether or not the subject of the application qualifies as a protectable/registrable ID. Thereafter, all applications, with the exceptions of those for textile designs, are sent to ARIPO for processing. Currently, Ghana acts as a receiving office for regional applications only; all applications received are treated as regional applications.

Step Five: Opposition to Registration

Upon submission, the RGD examines the application to determine whether or not the application meets the requirements of the IDA. Upon such determination, the application is published, and an interested person may file a notice of opposition to registration within two months on the grounds that either the ID is not an ID as defined by the IDA or that the applicant does not have a right to registration of the ID. If an objection is filed, the RGD sends notice of the objection to the applicant, after which the applicant has an opportunity to file a counter-objection. The party making an objection or the original applicant may apply for an extension of time to file the notice of opposition or to prepare a response to opposition, if needed. If no counter-objection is filed, the application is deemed abandoned and registration is denied. If a counter-objection is filed, the RGD sends such counter-objection to the person who filed the notice of opposition.

Step Six: Registration and Publication

Where the RGD finds that the requirements of registration have been fulfilled and the registration of the ID either has not been opposed within the prescribed time, the RGD registers the ID, publishes notice of registration and issues the applicant a certificate of registration. A certificate of registration will also be issued where the RGD decides in favor of the applicant where the registration of the ID was opposed upon publication. Anyone who is denied registration of an ID may appeal to the High Court.

Filings Upon Change of Ownership and Licensing of Industrial Designs

Any changes in ownership of an ID must be in writing and filed with the RGD, who publishes notice of such change in ownership. Likewise, copies of any licensing contract concerning a registered ID or an application for the registration of an ID must be submitted to the RGD, who will keep details secret, but will record and publish notice of such contract. Changes in ownership or license contracts are not effective against third parties until they have been recorded and published.

Enforcement Approaches

Criminal Enforcement

The Commercial Crime Unit (CCU) of the Criminal Investigation Department (CID) – Ghana Police Service

For infringing goods that are suspected of having been produced in Ghana or have been imported into Ghana, rights-holders may approach the Commercial Crime Unit (CCU) of the Criminal Investigation Department (CID) of the Ghana Police Service.

The majority of the CCU's investigations into IP infringement originate from tips from either rights-holders or from informants. Under Ghanaian law, there is a reward for information that leads to the discovery of infringing goods and conviction of the infringer; certain enterprising individuals make their living as professional informants. Upon receiving a tip about infringing goods, the CCU will investigate and upon confirmation that the goods are infringing, is empowered to seize the infringing goods and to arrest any persons in possession of infringing goods. The CCU may allow rights-holders to participate in raids.

The Preventive Unit of CID has a Rapid Response Unit (RRU) that has the capacity to prevent the often quick dissemination of infringing goods. The RRU is used when it is known to a high degree of certainty the location and means by which a shipment of infringing or otherwise illicit products are entering the country. A court order is usually required before the RRU will investigate possible IPR violations.

Criminal Prosecution

The Criminal Code 1960 (Code) defines a list of types of fraud, including intellectual property fraud. While most often IP fraud is prosecuted under the relevant IP law, upon occasion a charge may be brought under the Code for fraud or fraudulent representation, if the authorities deem it more relevant. If charges are brought under the Code rather than under IPR laws, a rights-holder may elect to pursue damages under the Unfair Competition Act. Anyone found guilty of infringement under the IDA may be sentenced to a maximum of 2 years in prison.

Criminal prosecution can better deter violators from repeating their crimes. Many individuals may commit intellectual property crimes not only because they can be relatively easy to commit, but also because the perpetrators believe that they will not be prosecuted. Criminal prosecution plays an important role in establishing public expectations of right and wrong, and in educating the public about intellectual property rights. If you believe that you are a victim of intellectual property theft, we recommend that you document all investigative steps, preserve evidence and contact the relevant authorities right away. Intellectual property crimes may be reported to the relevant offices (e.g., the RGD) and to either Customs, Chief Collector, Preventative OPS - Headquarters (for import and export of infringing goods) at +233 (0)302 686106/684363 or +233 (0)244 364 642 or via email at pr@ghanacustoms.gov.gh or the CCU at +233 (0)302 76 17 34.

You may also submit a tip through the Ghana Police Service website at <http://www.ghanapolice.info/>

Administrative Enforcement

The Customs Division of the Ghana Revenue Authority

One of the agencies that rights-holders may approach for assistance in combating infringement is the Customs Division of the Ghana Revenue Authority (formerly known as the Customs, Excise and Preventive Service (CEPS)) (Customs).

Businesses exporting products that carry a high risk of being infringed are encouraged to work directly with Customs. The Preventive Department within Customs is chiefly responsible for blocking infringing goods and otherwise illicit material from entering the country. Businesses that export high risk products should supply the Preventive Department of Customs with a detailed description and sample of their product.

Infringing products are known to enter Ghana from its ports and multiple borders. Customs recommends that if a rights-holder believes that infringing products are entering the country from multiple entry points that the rights-holder hold an informational workshop. Customs officers from around the country attend workshops in which producers and rights-holders describe and supply prototype authentic and infringing goods. The more detailed the information and training provided by the rights-holder, the more likely Customs officers are to stop infringing goods at the ports and borders.

If a Customs agent believes that a shipment of products contains infringing goods, the agent can stop the shipment at the border. When infringing goods have entered the country and are being warehoused, distributed or retailed, Customs officers are authorized to enter a warehouse, factory or store and take an account of the excisable goods in the custody or possession of the seller. Customs officers are further authorized to take samples of goods suspected of being infringing, to the extent that the usual price of goods is paid. When the Commissioner of the Customs Division of the Ghana Revenue Authority (Commissioner) is satisfied by information and samples that there is reasonable cause to suspect that infringing goods are harbored, kept, or concealed in any premises, the Commissioner may issue a written order authorizing an officer to enter and search the

premises, and to seize and take away any of the infringing goods. In addition to seizure of any infringing goods, Customs officers may also arrest any person in whose possession and under whose control the infringing goods are found.

The law provides for a reward for any person whose “tip-off” leads to the confiscation of counterfeit goods and the arrest of anyone dealing in counterfeits. Customs regularly benefits from tip-offs from private citizens in addition to receiving information from rights-holders and discovery of infringing goods by members of the Customs units themselves.

Rights-holders with the requisite evidence may submit a written request of detention to Customs independent of any Customs investigation or action. The request must provide evidence that demonstrates a high likelihood that infringement is occurring and that injunctive action is necessary to avoid further damage; such request may or may not require a court order. Rights-holders should also provide evidence of ownership of the ID.

In discussions, Customs indicated that a bond is normally only required in situations where the goods themselves are “gray market”, that is, authentic, but sold outside an authorized sales territory or by an unauthorized dealer in an authorized sales territory. Under these circumstances, the goods are impounded and a bond paid until the parties have reached an agreement on the goods or a court has determined the outcome of the dispute.

Upon occasion, Customs will allow rights-holders more direct participation beyond informing the Preventive Department that infringement is occurring. In order for a rights-holder to participate more directly in Customs anti-counterfeiting investigations and procedures, Customs requires the producer to demonstrate in writing reasonable grounds for suspecting that infringing products are entering or being sold within the country.

It is recommended that rights-holders pay a courtesy call to Customs officials upon entering the Ghanaian market, provide Customs with copies of originals and hints on how to spot pirated goods and to establish a relationship with Customs on an ongoing basis, providing information, intelligence and training and support. Face-to-face interaction with enforcement officials may be a more effective means of communication than phone or email.

Civil Enforcement

Cancellation

An interested person may apply to the High Court for cancellation of a registered ID on the grounds that the registered ID is not an ID within the definition of the IDA or that the registered owner is not the creator or the creator’s successor in title. Burden of proof is on the person requesting cancellation. A cancelled ID or part thereof is void as of the day of registration.

Civil Litigation

On the request of the rights-holder, the High Court may grant an injunction to prevent infringement or imminent infringement, award damages and grant any other relief provided for in the general law.

There are three types of High courts in Ghana: the standard High Courts, the “fast track” High Courts and the commercial High Courts. While each offers its own advantages, judges on the commercial courts tend to be more IP-savvy, many having completed IP training. Under the rules of civil procedure, the High Court may grant an award of damages to a rights-holder if it is determined that infringement has occurred. Burden of proof for an award of damages is on the rights-holder, and the amount of damages is determined by the High Court.

The chief advantage of pursuing IPR claims in civil litigation is that unlike criminal proceedings, they may be initiated directly by the rights-holder. Court actions under the IDA may be instituted either by the registered owner or a licensee who has requested the registered owner to institute proceedings for a specific relief and the registered owner has refused or failed to do so. Rights-holders are advised to engage local counsel experienced in IPR issues in the event of any litigation.

Other Measures

NGOs and Professional Organizations

Several non-governmental organizations in Ghana play important roles in helping enforce IPR, including participating in public information campaigns, reporting suspected infringements and training government personnel. Rights-holders are encouraged to seek out such NGOs for information and support. These organizations include:

- Business Coalition Against Counterfeiting and Illicit Trade (CACIT)
<http://bcacit.com/home/index.php>
- Ghana Employers’ Association (GEA)
<http://www.ghanaemployers.com/>
- Institute of Packaging Ghana
<http://www.iopg.org.gh/>
- The Association of Ghanaian Industries
<http://www.agighana.org/>
- The Consumers’ Association of Ghana
Tel: +233 (0)302 784461; +233 (0)302 238042

Rights-holders may find it useful to work with one or more of these organizations in protecting their IPR.

Public Information Campaigns

In general, public awareness in Ghana is the cornerstone of a successful IPR protection plan. Upon detection of infringing products entering the Ghanaian market, rights-holders have informed the public of the illegal nature of infringing products, with varying degrees of success. In the past, public relations campaigns have resulted in the return of a portion of the infringing products that have infiltrated legitimate retail businesses. Rights-holders may also contact relevant agencies and offer training in differentiating authentic versus infringing products to those individuals charged with search and seizure.

FAQ

1. Do I have to register an ID in order to be protected?

Yes. Absent a registration, there are no exclusive rights to an ID.

2. If I want to register my ID in Ghana, where do I go?

Registration is made with the Registrar-General's Department. You may contact them outside of Ghana at +233 (0)302 664 691-93 or visit their website at <http://rgd.gov.gh>.

3. How long is protection for an ID available?

The registration of an ID is valid for a period of five (5) years from the filing date of the application and may be renewed for two further consecutive periods of five years upon payment of a renewal fee.

4. What are the penalties under the IDA?

Violations under the IDA are punishable by a fine not exceeding 2000 penalty units (currently a penalty unit is equal to GHC 12.00; the current maximum fine would be GHC 24,000) or to a term of imprisonment not exceeding two years or to both.

5. My design was made public six (6) months ago. Can I still register for protection?

Yes. An ID that is disclosed to the public is still eligible for protection if an application for registration is filed within 12 months of disclosure or where applicable, the priority date of the application and was due to a result of acts committed by the applicant or applicant's predecessor in title or an abuse committed by a third party.

We strongly emphasize that the information provided in this Toolkit does not constitute legal advice and should not be a substitute for advice of legal counsel. Its intended purpose is to provide an overview of Ghana's IPR environment, available enforcement mechanisms and Ghanaian government offices sharing jurisdiction over IPR protection and enforcement. We recommend that U.S. companies seeking to do business in Ghana or facing IPR infringement issues in Ghana seek qualified U.S. and/or Ghanaian legal counsel in pursuing their rights

through Ghana's IPR enforcement regime. The U.S. Government, the U.S. Department of State, the U.S. Department of Commerce, their employees and contractors assume no legal liability for the accuracy or completeness or usefulness of any information, resource or process contained disclosed herein.